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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,554	09/09/2003	Joshua Susser	P-3709CNT	3094

7590 09/25/2007

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EXAMINER	
HENEGHAN, MATTHEW E	

ART UNIT	PAPER NUMBER
2134	

MAIL DATE	DELIVERY MODE
09/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/659,554	SUSSER ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30-51,53 and 57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30-51,53 and 57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the previous office action, Applicant has cancelled claims 1, 52, and 54-56 and amended claims 30, 43, 47, 51, 53, and 57. Claims 30-51, 53, and 57 have been examined.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "memory medium" as recited in claim 51 et al. is not used in the specification. It is being presumed that the term encompasses volatile and non-volatile memory and carrier waves.

Claim Objections

3. Claim 43 is objected to because of the following informalities: The term "said zero or more sets of instructions" in line 4 lacks antecedent basis. It is being presumed that the word "said" should be omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 51 and 53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "tangible memory medium" is not used in Applicant's original specification.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 30, 47, 51, 53, and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S.

Patent No. 6,823,520. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the claims are anticipated by claims 1-2 of the '520 patent. Since all programs have entry points, the accessing of such a program across a context barrier must necessarily involve the use of an entry point.

6. Claims 30, 47, 51, 53, and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,907,608. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the claims are anticipated by claims 1-4 of the '608 patent. Since all programs have entry points, the accessing of such a program across a context barrier must necessarily involve the use of an entry point.

7. Claims 30-51, 53, and 57 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,922,835. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the instant application are anticipated by the claims of the '835 patent.

8. Claims 30-51, 53, and 57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 23-50 of

copending Application No. 10/995,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because the first three limitations of claim 1 of the '926 application of anticipate the first three limitation of claim 1 of the instant application; regarding the fourth limitation, since all programs have entry points, the accessing of such a program across a context barrier must necessarily involve the use of an entry point. Claims 30-57 correspond to claims 23-50 of the '926 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 30-51, 53, and 57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/996,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the first three limitations of claim 1 of the '266 application of anticipate the first three limitation of claim 1 of the instant application; regarding the fourth limitation, since all programs have entry points, the accessing of such a program across a context barrier must necessarily involve the use of an entry point. Claims 30-57 correspond to claims 25-56 of the '266 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 30-51, 53, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by WIPO Patent Publication No. WO 97/06516 to De Jong.

As per claims 1, 30, 35, 41, 43, 45, 47, 49, 51, 53, and 57 De Jong discloses a small footprint device such as a smartcard (see abstract) having processing and memory means (see p. 16, lines 22-27) in which a context barrier exists to separate applications and data from one another. Zero or more sets of programs and data may interact with one another according to access conditions (see p.22, line 23 to p. 23, line 16). Entry points are enumerated in a data list (see p. 23, lines 17-26). The listing and enforcing of external interfaces for procedures, including restrictions according to principals and objects, constitutes a context barrier between the objects (see p. 19, line 11 to p. 21, line 31). The application description describing each object and its authorized interactions constitutes header data (see p. 18, line 12 to p. 19, line 10).

As per claim 31, separate names (name spaces) exist for each of the applications (see p. 31, lines 34-36).

As per claim 32, any programs, regardless of name space, may address any other, as per the data lists, above.

Regarding claims 33 and 34, since the applications exist in separate execution environments (see p. 31, lines 29-34), they must exist in separate memory spaces, as allocated by the OS.

Regarding claims 36, 38, 42, 46, 50, since functions may be invoked according to name or by memory pointer and its corresponding storage space, the corresponding security check results from that invocation.

Regarding claims 37 and 39, situations exist in which routines can be carried out without security checks (see p. 25, lines 26-31).

Regarding claim 40, 44, and 48, any information not for external access within an object may be protected, making it inaccessible to other modules (see p. 21, line 20 to p. 22, line 8)

Response to Arguments

11. Regarding Applicant's arguments concerning the rejections under 35 U.S.C. 112, second paragraph, Applicant's arguments are persuasive and the rejections are withdrawn.

12. Applicant's arguments filed 17 July 2007 have been fully considered but they are not persuasive.

Regarding the non-considered items in the IDS filed 9 September 2003, the exception to the submission requirement only extends to items in a parent application if those submissions conform with 37 CFR (a)-(c). See 37 CFR(d)(2).

An illegible item in an IDS is in violation of 37 CFR 1.98(a)(2). An untranslated foreign patent reference is in violation of 37 CFR 1.98(a)(3)(i).

Regarding the objection to the specification, material that is in the original claims in not considered to be in the specification. In order to provide proper antecedent basis for the term "memory medium," Applicant must amend the specification without adding new matter.

Regarding the double-patenting rejections, the use of entry points in the cited patents and patent applications is implicit and further modification of the cited references is therefore not necessary to establish obviousness. The presence of additional limitations in the references over and above those that are recited in the instant application does not make any rejection improper. Given that the cited references are analogous art, a motivation to modify is not required to establish obviousness.

Regarding the rejections under 35 U.S.C. 102 over DeJong, In the examination of a patent application, the meanings of claim terms are given their broadest reasonable interpretation in light of Applicant's specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc). The mechanism disclosed by DeJong constitutes a "context barrier" insofar as the term is defined in Applicant's specification.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

September 20, 2007 Patent Examiner (FSA), USPTO Art Unit 2134